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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Kip Van Steenburg

Serial No.: 09/660,433

Art Unit: 3673

Filed: September 7, 2000

Examiner: Michael Trettel

For: LEG HOLDER SYSTEM FOR SIMULTANEOUS POSITIONING IN THE
ABDUCTION AND LITHOTOMY DIMENSIONS

SUBMISSION OF APPELLANT'S BRIEF
UNDER 37 C.F.R. 1.192

Honorable Assistant Commissioner
for Patents
Washington, D.C. 20231

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GROUP 3600

Sir:

Enclosed is Appellant's Brief in triplicate with a check for the required fee of
\$320.00.

It is respectfully requested that, if necessary to effect a timely response, this paper be
considered as a Petition for an Extension of Time sufficient to effect a timely response and
shortages in other fees, be charged, or any overpayment in fees be credited, to the Account of
Barnes & Thornburg, Deposit Account No. 10-0435 (7175-65430).

Respectfully submitted,

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Enclosure
65567v1



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APPEAL BRIEF

Honorable Assistant Commissioner
for Patents
Washington, D.C. 20231

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Sir:

Below is an Appeal Brief in support of an appeal taken from the Final Rejection of claims 1-100 mailed May 21, 2002. A Notice of Appeal was filed November 19, 2002 with a request and fee for a three-month extension of time.

1. **Real party in interest.** All rights in this application have been assigned to The OR Group, Inc., a corporation existing under the laws of the state of Indiana.

2. **Related appeals and interferences.** Appellant, undersigned counsel for appellant, and assignee know of no appeals or interferences related to the present application on appeal.

3. **Status of Claims.** The application contains Claims 1-100.

Claims 14-100 have been rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based.

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4. **Status of Amendments.** All amendments filed by appellant have been entered and considered by the examiner. On May 21, 2002, a final rejection of pending claims 14-100 was issued. Appellant has not filed an after final amendment. Appellant's notice of appeal was filed November 19, 2002.

5. **Summary of the Invention.** As best seen in Fig. 1, the invention is directed to a leg holder system 10 for simultaneously positioning in the abduction and lithotomy dimensions (see axes 36 and 72, respectively as best seen in Fig. 3) including a support device 12 for supporting a leg cradle 200; a clamping device 14 for mounting the proximate end of the support device 12 to a mounting device 34 having a first axis 36 and for selectively clamping and releasing the support device 12 about the first axis 36 and about a second axis 72 transverse to the first axis. An actuator device 16 for actuating the clamp 14 to selectively clamp and release simultaneously the support device 12 and the mounting device 34; and an operator device 18 remote from the clamping device 14 and actuator device 16 for operating the actuator device 16 to enable the support device 12 to move simultaneously about the first and second axis (axes 36 and 72, respectively) in both the abduction and lithotomy dimensions (along axes 36 and 72, respectively).

6. **Issue on appeal.** Whether Claims 14-100 are unpatentable under 35 U.S.C. 251 for improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based.¹

7. **Grouping of Claims.** Claims 14-100 stand or fall as follows. There are six new independent claims added by this reissue (claims 14, 24, 48, 72, 81 and 91). These six new independent claims stand or fall individually. Dependent claims 15, 16, 19, 31, 33, 34, 55, 62, 76, 77, 78, 84, 85, 89, 94, 95 and 99 are also separately argued and they stand or fall

¹ Claims 1-13 have not been amended from U.S. Patent No. 5,802,641 and are identical to claims 1-13 of U.S. Patent No. 5,802,641 of which the present application seeks reissue. The final office action of May 21, 2002 indicates in the summary (form PTO-326) that claims 1-100 are rejected, however, the body of the office action states "[c]laims 14-100 are rejected under 35 U.S.C. 251 ..." with no mention of claims 1-13. Since claims 1-13 are not amended or referenced in the actual rejection on pages 2-6 of the final office action it is apparent that they are not subject to the recapture rejection. Claims 1-13 are treated in this appeal brief as allowed since there is no clear statement of a basis for their rejection. Alternatively, should the Board of Patent Appeals and Interferences determine that claims 1-13 are stated to be rejected for recapture it is requested that such rejection be reversed on the basis that they are without amendment and thus cannot seek to recapture subject matter omitted during prosecution of U.S. Patent No. 5,802,641.

separately. Dependent claims 17-18 stand or fall with claim 16, dependent claim 20 stands or falls with claim 19, dependent claims 21-23 stand or fall with claim 14, dependent claims 25-30, 32 and 35-47 stand or fall with claim 24, dependent claims 49-54, 56-61 and 63-71 stand or fall with claim 48, dependent claims 82-83, 86-88 and 90 stand or fall with claim 81, and dependent claims 92-93, 96-98 and 1000 stand or fall with claim 91.

8. **Copy of the Claims.** A copy of the Claims on appeal is attached to this Brief as Appendix A.

9. **Argument.**

The recapture law.

The recapture rule prevents a patentee from regaining through reissue the subject matter surrendered in an effort to obtain the allowance of the original claims.² Application of the recapture rule is a three-step process.³ The three steps are; to determine whether and in what aspect the reissue claims are broader than the patent claims; whether the broader aspects of the reissued claim related to surrendered subject matter; and, whether the reissued claims were materially narrowed in other respects to avoid the recapture rule.

The Rejection of Claims 14-100 under 35 U.S.C. 251.

The final office Action rejects claims 14-100 for improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based. The final office action states that

Claims 14-100 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based....

The applicant is attempting to claim the supporting device without reference to a longitudinal axis and a clamping device having an axis transverse to the longitudinal axis. The applicant is also attempting to drop out any reference to a clamping device that can simultaneously clamp and release the supporting device relative to the clamping device about the first and second (longitudinal and traverse) axes. These limitations were

² In re Clement, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997).

³ Pannu v. Storz Instruments Inc., 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001).

expressly added during the prosecution of the 08/813708 application in order to define over the subject matter disclosed in the Klevstad patent. These inclusions of these limitations in the original claims 1 to 13 were also relied upon by applicant as part of the arguments used to secure an allowance over the Klevstad patent....

At page 3 of the final office action it is argued that the following phrases were added by amendment and are dropped from the reissue claims:

1. the specific reference to the abduction dimension and lithotomy dimension in lines 2 and 3 of claim 1
2. the limitation of "having a longitudinal axis" in line 4 of claim 1
3. the limitation of "transverse to said longitudinal axis" in line 8 of claim 1
4. the mounting device having a first axis
5. "simultaneously" in claim 1, line 9
6. the limitation concerning the support device being fixed in the clamping device against rotation about said longitudinal axis in claim 1, lines 11-13
7. limitations stating the actuator device actuates the clamping device for simultaneously clamping the support device and mounting device in claim 1, lines 14-15.

The Final Office Action Does Not Present A Prima Facie Case Of Recapture.

The final office action generally avers that appellant argued the importance of the above items. Such general averment is a conclusion without proper supportive reasoning. In order that the final office action provide a prima facie case of recapture it must demonstrate that during prosecution of applicant's '641 patent appellant argued limitations not present in the reissue claims. As noted above, the final rejection refers to seven limitations which "[t]he claims drop out", but does not point to any specific arguments by appellant relating to these dropped out limitations. Rather the final action refers only generally to arguments in the amendment of February 17, 1998 filed during prosecution of parent application serial No. 813,708 filed March 7, 1977. There is no proper explanation in the final office action pointing to specific arguments by appellant that amount to recapture. Moreover, the allegedly dropped limitations appear to point to claim amendments without demonstrating that such limitations are actually dropped from the reissue or that such limitations were actually argued and surrendered. Recapture is not present merely where there is a

broadening. The first step in applying the recapture rule is to determine whether and in what “aspect” the reissue claims are broader than the patent claims.... The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter.⁴ The final office action does not compare the allegedly dropped subject matter with the corresponding subject matter in the present reissue claims. Rather the final office action improperly concludes the subject matter is dropped without establishing with proper reasoning that the corresponding subject matter in the present reissue claims is an improper broadening. Furthermore, the final office action fails to consider whether the amended limitations constitute a material narrowing in other respects so that the recapture doctrine is avoided. For each of these reasons, the rejection should be reversed.

Whether, And In What Aspect, Are The Reissue Claims Broader
Than The Patent Claims?

U.S. Patent No. 5,802,641 (of which the present application seeks reissue) was filed as application serial No. 813,708 on March 7, 1977 and issued on September 8, 1998. The prosecution history shows there was only one office action rejection (mailed November 14, 1997) and only one amendment (filed February 17, 1998) and argument by appellant. The following will demonstrate by providing at least one example for each allegedly dropped item that appellant’s argument and amendment during prosecution of U.S. Patent No. 4,426,071 unquestionably does not provide a basis for recapture.

The rejection mailed November 17, 1997 states that claims 1 to 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite and states that claims 1, 4, 7 and 12 are rejected under 35 U.S.C. 102(b) as anticipated by Klevstad (U.S. Patent No. 4,426,071). Appellant’s amendment filed February 17, 1998 amended the claims to provide clarification to overcome the indefiniteness. Arguments were submitted pointing out differences between Kevstad and the claims. However, as will become evident from the following comments, the subject matter allegedly dropped as stated in the final office action of May 21, 2002 is not a proper basis for the present recapture rejection.

Appendix B includes a side by side comparison of independent patented claim 1 (amendments during prosecution are shown with additions underlined and removed subject

⁴ See Clement, *Supra*, at 1104.

matter in brackets) and each of the independent reissue claims 14, 24, 48, 72, 81 and 91.⁵ Comparison of these claims demonstrates that the allegedly dropped subject matter has not been dropped and there is no evidence of any impermissible broadening of the present reissue claims.

Claims 14-23 Are Not Impermissibly Broadened..

The side by side comparison of claims 1 and 14 demonstrates that

1) the allegedly dropped abduction and lithotomy limitation has not been improperly removed from claim 14. The abduction and lithotomy limitation is clearly described at column 3, lines 60-61 of the '641 patent and are shown, for example, in the Fig. 3 preferred embodiment as axes 36 and 72, respectively. Claim 14 recites

a clamping device coupling the support device to a mounting device, the clamping device being configured to clamp the motion of the support device relative to the mounting device and to release the support device for rotative movement relative to the mounting device about a second plurality of axes, the leg cradle being movable about the first plurality of axes when the support device is clamped against movement about the second plurality of axes....

As is apparent from the side by side comparison of new claim 14 and patented claim 1, the second plurality of axes relates to the abduction and lithotomy axes in the preferred embodiment. Although the wording is changed, the subject matter is common to both claims. Thus, with respect to this aspect, claim 14 was not materially broadened and does not violate the recapture rule.

2) the allegedly dropped support device longitudinal axis 80 has not been improperly removed from claim 14. Claim 14 recites a first plurality of axes relative to the support device. The first plurality of axes is described in the specification with respect to the preferred embodiment as axes 204, 80a (80 and 80a both represent the tube axis about which the handle rotates). See col. 3, lines 62-64 and col. 5, lines 35-38 of the '641 patent. Thus, claim 14 in the preferred embodiment is at least as limiting and is not impermissibly broadened in this aspect.

⁵ In Attachment B numbers are added for ease of understanding the recapture issues. The numbers are from a preferred embodiment and the claims are not limited by the preferred embodiment.

3) the allegedly dropped “transverse to said longitudinal axis 80” limitation relates to the abduction or lithotomy axes which are not improperly removed from claim 14 in the preferred embodiment. As explained above with respect to the allegedly dropped abduction and lithotomy limitation, the abduction and lithotomy limitation is clearly represented in the claim 14 as related to the preferred embodiment as the second plurality of axes. Clearly, claim 14 is not impermissibly broadened in this aspect.

4) the allegedly dropped limitation of the mounting device having a first axis also relates to the abduction and lithotomy limitation and is not improperly removed from claim 14 when referencing the preferred embodiment. Claim 14 clearly recites “movement relative to the mounting device about a second plurality of axes” which again relates to the abduction and lithotomy limitation when referencing the preferred embodiment. Thus, the allegedly dropped limitation is not removed, but is stated in different terms which is not a impermissible broadening of the allegedly dropped limitation.

5) the allegedly dropped limitation “simultaneously” in claim 1, line 9 has not been improperly removed from claim 14. The term “simultaneously” as used in claim 1 refers to the ability to both clamp and release. Claim 14 recites a clamping device coupling the support device to a mounting device, the clamping device being configured to clamp the motion of the support device relative to the mounting device and to release the support device for rotative movement. Claim 14 related to the preferred embodiment recites that the clamping device is configured to both clamp and release. Accordingly, there has been no impermissible broadening of claim 14 in this aspect.

6) the allegedly dropped limitation concerning the support device being fixed in the clamping device against rotation about said longitudinal axis in claim 1, lines 11-13, has not been improperly removed from claim 14. The final rejection while urging that the limitation is dropped goes on to point out that “and now states that the support device is clamped against movement about the second plurality of axes”. There is no discussion of why the release for movement with respect to two axes limitation is relevant to the allegedly dropped clamping limitation. The comparison is confusing and the final office action does not explain how the comparison is relevant to the recapture issue. The comparison does not explain how anyone could consider the allegedly dropped limitation to be an improper broadening so as to amount to recapture. Claim 14 continues to recite that the support device is fixed to the clamping device, namely

a clamping device coupling the support device to a mounting device, the clamping device being configured to clamp the motion of the support device relative to the mounting device and to release the support device for rotative movement relative to the mounting device about a second plurality of axes, the leg cradle being movable about the first plurality of axes when the support device is clamped against movement about the second plurality of axes....

The above clamping of the support device includes clamping against rotation about its longitudinal axis in the preferred embodiment. There is no impermissible broadening. Release to permit motion about two axes is another matter and is not suggestive of improper broadening or recapture. There has been no impermissible broadening of claim 14 in this aspect.

7) the allegedly dropped limitation that the actuator device actuates the clamping device for simultaneously clamping the support device and mounting device in claim 1, lines 14-15, is not improperly removed from claim 14. The final rejection while urging that the limitation is dropped goes on to point out that "and now states that the clamping device can selectively clamp and release the support device relative to the mounting device." There is no discussion of how this change could be considered to be an improper broadening so as to amount to recapture. The claim 14 recitation of "an actuator device configured to move the clamping device to selectively clamp and release the support device relative to the mounting device" is not an impermissible broadening. The claim 14 actuator device actuates (is configured to move) the clamping device for clamping the support device and mounting device, or as stated in claim 14, the support device relative to the mounting device. There is no material difference between what is allegedly removed and the corresponding language of claim 14. The final rejection does not point to any material difference and appellant submits that there has been no impermissible broadening of claim 14 in this aspect.

Appellant's Prosecution Arguments During Prosecution Of The '641 Patent Are Not Directed To Subject Matter Omitted From The Present Reissue Claims.

Appellant's arguments in the amendment of February 17, 1998 filed during prosecution of parent application serial No. 813,708 filed March 7, 1977 are relatively brief. Many of the statements on pages 3-6 of the amendment explain what is being claimed. The arguments, in effect, assert that the shaft 39 of Klevstad (asserted in the parent application office action of November 14, 1997 to be the support device) is not for supporting a leg

cradle and does not disclose a mounting device for clamping and releasing the support device to allow rotative movement relative to the mounting device about two axes. Appellant argued that mechanism 43 in Klevstad does not release shaft 39 to allow rotative movement about two axes with respect to the mounting device 43. When released the shaft 39 could only be extended and/or rotated, it could not be rotated about two axes with respect to mounting device 43. Thus, it is clear that the argument for patentability to be considered in recapture is limited to this two axis release irrespective of limitations alleged to have been dropped in this reissue. The seven limitations alleged in the final office action of May 21, 2002 to have been dropped have not been impermissibly dropped (as explained above) and appellant's limited patentability arguments during prosecution of the '641 patent do not amount to recapture of any of these seven limitations.

Claims 14-23.

The following provides at least one example for each allegedly dropped item explaining how the appellant's prosecution argument pertains to limitations in claim 14.

1) Regarding the allegedly dropped abduction and lithotomy limitation, appellant's arguments during prosecution of the '641 patent regarding this limitation are applicable to the second plurality of axes recited in claim 14. The arguments do not relate to dropped subject matter and there is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

2) Regarding the allegedly dropped support device longitudinal axis, appellant's arguments during prosecution of the '641 patent regarding this limitation are applicable to at least the claim 14 limitation of a support device and a second plurality of axes. The argument that Klevstad does not teach a support device that is fixed from rotation about its own longitudinal axis is applicable to the limitations in claim 14 which fix the support device to the mounting device and permit movement about a second plurality of axes. There is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

3) Regarding the allegedly dropped "transverse to said longitudinal axis", appellant's arguments during prosecution of the '641 patent with respect to this limitation refer to the abduction or lithotomy axes which remain in claim 14 as the second plurality of axes. Claim 14 is not materially narrowed in this aspect.

4) Regarding the allegedly dropped limitation of the mounting device having a first axis, appellant's arguments during prosecution of the '641 patent regarding this limitation are applicable to at least the claim 14 limitation of the second plurality of axes recited in claim 14. The arguments to do not relate to dropped subject matter and there is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

5) Regarding the allegedly dropped limitation "simultaneously", appellant's arguments during prosecution of the '641 patent with respect to this limitation refer to the ability to both clamp and release which is in claim 14, "a clamping device coupling the support device to a mounting device, the clamping device being configured to clamp the motion of the support device relative to the mounting device and to release the support device for rotative movement". The arguments to do not relate to dropped subject matter and there is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

6) Regarding the allegedly dropped limitation concerning the support device being fixed in the clamping device against rotation about said longitudinal axis, appellant's arguments during prosecution of the '641 patent with respect to this limitation refer to the claim 14 limitation of coupling the support device to the mounting device. The argument that Klevstad does not teach a support device that is fixed from rotation about its own longitudinal axis is applicable to the limitations in claim 14 which fix the support device to the mounting device and permit movement about a second plurality of axes. There is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

7) Regarding the allegedly dropped limitation that the actuator device actuates the clamping device for simultaneously clamping the support device and mounting device, appellant's arguments during prosecution of the '641 patent with respect to this limitation refer to the ability to both clamp and release which is in claim 14, "a clamping device coupling the support device to a mounting device, the clamping device being configured to clamp the motion of the support device relative to the mounting device and to release the support device for rotative movement". The prosecution arguments do not relate to dropped subject matter and there is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

For at least these reasons, the final office action does not provide a proper basis for the rejection of claim 14. The final office action does not explain how the allegedly dropped limitations are in fact material when considered with respect to the corresponding limitations

of claim 14. Also, the final office action does not compare appellant's prosecution arguments with claim 14 pointing out subject matter actually dropped, or even subject matter allegedly dropped. Accordingly, the recapture rejection should be reversed.

Claim 15

Dependent claim 15 avoids the 35 U.S.C. 251 recapture rejection for the same reasons as recited above with respect to claim 14. Claim 15 further requires that the second plurality of pivot axes includes a first axis about which the support device rotates in an abduction dimension and a second axis about which the support device rotates in a lithotomy dimension. Thus, it is apparent that the allegedly dropped abduction and lithotomy limitation is not dropped from claim 15 and appellant's limited patentability arguments during prosecution of the '641 patent do not amount to recapture of the allegedly dropped limitations.

Claims 16 and 19

Dependent claims 16 and 19 avoid the 35 U.S.C. 251 recapture rejection for the same reasons as recited above with respect to claim 14. Dependent claim 16 further requires that the support device comprises an elongated member and claim 19 (dependent on claim 16) adds that the elongated member includes a tube. One of ordinary skill in the art knows that an elongated member and a tube have a longitudinal axis. Thus, it is apparent that the allegedly dropped "support device longitudinal axis" and "transverse to said longitudinal axis" limitations are not dropped from claims 16 and 19 and appellant's limited patentability arguments during prosecution of the '641 patent do not amount to recapture of the allegedly dropped limitations.

Claims 17, 18 and 21-23

Claims 17 and 18 depend from claim 16 and claim 20 depends from claim 19. Accordingly, claims 17, 18 and 20 avoid the 35 U.S.C. 251 recapture rejection for the same reasons as recited above with respect to claims 14, 16 and 19.

Claims 21-23 are dependent on claim 14 and avoid the 35 U.S.C. 251 recapture rejection for all of the reasons noted above with respect to claim 14.

Claims 24-47 Are Not Impermissibly Broadened.

Claims 24-47 avoid the 35 U.S.C. 251 improper recapture rejection for substantially the same reasons noted above with respect to claims 14-23. The following discussion provides at least one example to explain how claims 24-47 claim the allegedly dropped subject matter. It follows that the arguments and reasoning recited above with respect to claims 14-23 are also applicable, but for the sake of brevity all of the above stated arguments are not repeated.

The side by side comparison of claims 1 and 24 demonstrates that

1) the allegedly dropped abduction and lithotomy limitation has not been improperly removed from claim 24. The abduction and lithotomy limitation is clearly described at column 3, lines 60-61 of the '641 patent and are shown, for example, in the Fig. 3 preferred embodiment as axes 36 and 72, respectively. Claim 24 recites

a locking device coupled to the mounting device and coupled to the elongated member, the locking device being movable between a locking position in which the elongated member is fixed relative to the mounting device and a releasing position in which the elongated member is rotatable about a second plurality of axes relative to the mounting device....

As is apparent from the side by side comparison of new claim 24 and patented claim 1, the second plurality of axes relates to the abduction and lithotomy axes in the preferred embodiment. Although the wording is changed, the subject matter is common to both claims. Thus, with respect to this aspect, claim 24 was not materially broadened to violate the recapture rule.

2) the allegedly dropped support device longitudinal axis 80 has not been improperly removed from claim 24. Claim 24 includes an elongated member, a leg holder adapted to engage and support at least a portion of a leg of a patient and a coupler configured to couple the leg holder to the elongated member. The elongated member in the preferred embodiment has an axis 80. Thus, claim 24 in the preferred embodiment relates to this aspect and is not an impermissible broadening.

3) the allegedly dropped "transverse to said longitudinal axis 80" limitation relates to the abduction or lithotomy axes in the preferred embodiment which are not improperly removed from claim 24. As explained above with respect to the allegedly dropped abduction and lithotomy dimensions, both abduction and lithotomy dimensions are clearly represented

in the claim 24 preferred embodiment as the second plurality of axes. Clearly, claim 24 is not impermissibly broadened in this aspect.

4) the allegedly dropped limitation of the mounting device having a first axis also relates to the abduction and lithotomy limitation and is not improperly removed from claim 24 in the preferred embodiment. Claim 24 clearly recites “the locking device being movable between a locking position in which the elongated member is fixed relative to the mounting device and a releasing position in which the elongated member is rotatable about a second plurality of axes relative to the mounting device” which again relates to the abduction and lithotomy limitation in the preferred embodiment. Thus, the allegedly dropped limitation is not removed, but is stated in different terms which is not an impermissible broadening of the allegedly dropped limitation.

5) the allegedly dropped limitation “simultaneously” in claim 1, line 9 has not been improperly removed from claim 24. The term “simultaneously” as used in claim 1 refers to the ability to both clamp (or lock) and release. Claim 24 recites, for example, the operator device being movable to move the locking device between the locking position and the releasing position. Thus, claim 24 in the preferred embodiment recites that the operator device being movable to both clamp and release. Accordingly, there has been no impermissible broadening of claim 24 in this aspect.

6) the allegedly dropped limitation concerning the support device being fixed in the clamping device against rotation about said longitudinal axis has not been improperly removed from claim 24. Claim 24 continues to recite that the support device (elongated member in claim 24) is fixed to the clamping device (locking device in claim 24) , namely

the locking device being movable between a locking position in which the elongated member is fixed relative to the mounting device and a releasing position in which the elongated member is rotatable about a second plurality of axes relative to the mounting device....

It is submitted that the above “elongated member is fixed” includes clamping against rotation about its longitudinal axis as shown in the preferred embodiment. There is no impermissible broadening. Release to permit motion about two axes is another matter and is not suggestive of improper broadening or recapture. Thus, there has been no impermissible broadening of claim 24 in this aspect.

7) the allegedly dropped limitation that the actuator device actuates the clamping device for simultaneously clamping the support device and mounting device is not

improperly removed from claim 24. Appellant submits that the claim 24 recitation of “an operator device coupled to the elongated member and operatively coupled to the locking device, the coupler being positioned to lie between the operator device and the locking device, the operator device being movable to move the locking device between the locking position and the releasing position” is not an impermissible broadening. The claim 24 actuator device actuates the clamping device for clamping the support device and mounting device, or as stated in claim 24, the operator device being movable to move the locking device between the locking position and the releasing position. There is no material difference between what is allegedly removed and the corresponding language of claim 24. The final rejection does not point to any material difference and appellant submits that there has been no impermissible broadening of claim 24 in this aspect.

Claims 24-47.

Appellant’s Prosecution Arguments Are Not Directed To Omitted Subject Matter.

Appellant’s prosecution arguments during prosecution of the ‘641 patent are not directed to subject matter omitted from reissue claims 24-47. Claims 24-47 avoid the 35 U.S.C. 251 improper recapture rejection for substantially the same reasons noted above with respect to claims 14-23. It follows that the arguments and reasoning recited above with respect to claims 14-23 are also applicable, but for the sake of brevity all of the above stated arguments are not repeated. The following provides at least one example for each allegedly dropped item explaining how the appellant’s prosecution argument during prosecution of the ‘641 patent pertains to limitations in claim 24.

1) Regarding the allegedly dropped abduction and lithotomy limitation, appellant’s arguments during prosecution of the ‘641 patent regarding this limitation are applicable to the second plurality of axes recited in claim 24. The arguments do not relate to dropped subject matter and there is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

2) Regarding the allegedly dropped support device longitudinal axis, appellant’s arguments during prosecution of the ‘641 patent regarding this limitation are applicable to at least the claim 24 limitation of coupling the elongated member to the mounting device. The argument that Klevstad does not teach a support device that is fixed from rotation about its own longitudinal axis is applicable to the limitations in claim 24 which fix the elongated

member to the mounting device and permit movement about a second plurality of axes. Thus, there is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

3) Regarding the allegedly dropped “transverse to said longitudinal axis”, appellant’s arguments during prosecution of the ‘641 patent with respect to this limitation refer to the abduction or lithotomy axes in the preferred embodiment which remain in claim 24 as the second plurality of axes. Claim 24 is not materially narrowed in this aspect.

4) Regarding the allegedly dropped limitation of the mounting device having a first axis, appellant’s arguments during prosecution of the ‘641 patent regarding this limitation are applicable to at least the claim 24 limitation of the second plurality of axes recited in claim 24. The arguments to do not relate to dropped subject matter and, thus, there is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

5) Regarding the allegedly dropped limitation “simultaneously”, appellant’s arguments during prosecution of the ‘641 patent with respect to this limitation refer to the ability to both clamp (or fix) and release which is in claim 24, “a locking device coupled to the mounting device and coupled to the elongated member, the locking device being movable between a locking position in which the elongated member is fixed relative to the mounting device and a releasing position in which the elongated member is rotatable about a second plurality of axes relative to the mounting device,”. The arguments to do not relate to dropped subject matter and, thus, there is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

6) Regarding the allegedly dropped limitation concerning the support device being fixed in the clamping device against rotation about said longitudinal axis, appellant’s arguments during prosecution of the ‘641 patent with respect to this limitation refer to the claim 24 limitation of “a locking position in which the elongated member is fixed relative to the mounting device and a releasing position in which the elongated member is rotatable about a second plurality of axes relative to the mounting device”. The argument that Klevstad does not teach a support device that is fixed from rotation about its own longitudinal axis is applicable to the limitations in claim 24 which fix the elongated member to the mounting device and permit movement about a second plurality of axes. There is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

7) Regarding the allegedly dropped limitation that the actuator device actuates the clamping device for simultaneously clamping the support device and mounting device, appellant's arguments during prosecution of the '641 patent with respect to this limitation refer to the ability to both clamp and release which is in claim 24, "a locking device coupled to the mounting device and coupled to the elongated member, the locking device being movable between a locking position in which the elongated member is fixed relative to the mounting device and a releasing position in which the elongated member is rotatable about a second plurality of axes relative to the mounting device". The arguments do not relate to dropped subject matter and, thus, there is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

Claim 31

Dependent claim 31 avoids the 35 U.S.C. 251 recapture rejection for substantially the same reasons as recited above with respect to claim 24. Claim 31 further requires that the elongated member defines a longitudinal axis. Thus, it is apparent that the allegedly dropped limitation of "having a longitudinal axis" is not dropped from claim 31 and appellant's limited patentability arguments during prosecution of the '641 patent do not amount to recapture of the allegedly dropped limitations.

Claims 33 and 34

Dependent claims 33 and 34 avoid the 35 U.S.C. 251 recapture rejection for substantially the same reasons as recited above with respect to claim 24. Dependent claim 33 further requires that the elongated member includes a tube and claim 34 also refers to the tube. One of ordinary skill in the art knows that an elongated member and a tube have a longitudinal axis. Thus, it is apparent that the allegedly dropped "support device longitudinal axis" and "transverse to said longitudinal axis" limitations are not dropped from claims 33 and 34 and appellant's limited patentability arguments during prosecution of the '641 patent do not amount to recapture of the allegedly dropped limitations.

Claims 25-30, 32 and 35-47

Claims 25-30, 32 and 35-47 depend from claim 24. Accordingly, claims 25-30, 32 and 35-47 avoid the 35 U.S.C. 251 recapture rejection for substantially the same reasons as recited above with respect to claim 24.

Claims 48-71 Are Not Impermissibly Broadened.

Claims 48-71 avoid the 35 U.S.C. 251 improper recapture rejection for substantially the same reasons noted above with respect to claims 14-23 and 24-47. The following discussion provides at least one example to explain how claims 48-71 claim the allegedly dropped subject matter. It follows that the arguments and reasoning recited above with respect to claims 14-23 and 24-47 are also applicable, but for the sake of brevity all of the above stated arguments are not repeated.

The side by side comparison of claims 1 and 48 demonstrates that

1) the allegedly dropped abduction and lithotomy limitations have not been improperly removed from claim 48. The abduction and lithotomy limitations are clearly described at column 3, lines 60-61 of the '641 patent and are shown, for example, in the Fig. 3 preferred embodiment as axes 36 and 72, respectively. Claim 48 recites a plurality of axes. As is apparent from the side by side comparison of new claim 48 and patented claim 1, the plurality of axes therein relate to the abduction and lithotomy axes in the preferred embodiment. Although the wording is changed, the subject matter is common to both claims. Thus, with respect to this aspect, claim 48 was not materially broadened and does not violate the recapture rule.

2) the allegedly dropped support device longitudinal axis 80 has not been improperly removed from claim 48. Claim 48 includes a tube, a mounting device, a clamping device coupling the tube to the mounting device. The tube in the preferred embodiment has an axis 80. Thus, claim 48 in the preferred embodiment recites this aspect and there is no impermissible broadening.

3) the allegedly dropped "transverse to said longitudinal axis 80" limitation relates to the abduction or lithotomy axes which in the preferred embodiment are not improperly removed from claim 48. As explained above with respect to the allegedly dropped abduction and lithotomy limitations, both abduction and lithotomy limitations are clearly represented in

the claim 48 preferred embodiment as a plurality of axes. Clearly, claim 48 is not impermissibly broadened in this aspect.

4) the allegedly dropped limitation of the mounting device having a first axis also relates to the abduction and lithotomy limitation in the preferred embodiment and is not improperly removed from claim 48. Claim 48 clearly recites “a tube, a mounting device, a clamping device coupling the tube to the mounting device, the clamping device being movable between a normal condition having the tube fixed relative to the mounting device and a release condition in which the tube is rotatable relative to the mounting device about a plurality of axes” which again relates to the abduction and lithotomy limitation in the preferred embodiment. Thus, the allegedly dropped limitation is not removed, but is stated in different terms which is not an impermissible broadening of the allegedly dropped limitation.

5) the allegedly dropped limitation “simultaneously” in claim 1, line 9 has not been improperly removed from claim 48. The term “simultaneously” as used in claim 1 refers to the ability to both clamp (or fix) and release. Claim 48 recites, for example, a clamping device coupling the tube to the mounting device, the clamping device being movable between a normal condition having the tube fixed relative to the mounting device and a release condition in which the tube is rotatable relative to the mounting device about a plurality of axes. Thus, claim 48 in the preferred embodiment recites the clamping device being movable between a fixed and a release condition. Accordingly, there has been no impermissible broadening of claim 48 in this aspect.

6) the allegedly dropped limitation concerning the support device being fixed in the clamping device against rotation about said longitudinal axis has not been improperly removed from claim 48. Claim 48 continues to recite that the support device (tube in claim 48) is fixed to the clamping device in claim 48, namely “the clamping device being movable between a normal condition having the tube fixed relative to the mounting device”. It is submitted that the above “tube fixed relative to the mounting device” relates to clamping against rotation about its longitudinal axis in the preferred embodiment. There is no impermissible broadening. Release to permit motion about two axes is another matter and is not suggestive of improper broadening or recapture. There has been no impermissible broadening of claim 48 in this aspect.

7) the allegedly dropped limitation that the actuator device actuates the clamping device for simultaneously clamping the support device and mounting device in claim 1 is not improperly removed from claim 48. Claim 48 recites “an operator device coupled to the tube at a second distance away from the clamping device, the second distance being greater than the first distance, the operator device being movable to move the clamping device between the normal condition and the release condition” which is not an impermissible broadening. The claim 48 actuator device actuates the clamping device for clamping the support device and mounting device, or as stated in claim 48, the operator device being movable to move the clamping device between the normal condition and the release condition. There is no material difference between what is allegedly removed and the corresponding language of claim 48. The final rejection does not point to any material difference and there has been no impermissible broadening of claim 48 in this aspect.

Claims 48-71.

Appellant’s Prosecution Arguments Are Not Directed To Omitted Subject Matter.

Appellant’s prosecution arguments during prosecution of the ‘641 patent are not directed to subject matter omitted from reissue claims 48-71. Claims 48-71 avoid the 35 U.S.C. 251 improper recapture rejection for substantially the same reasons noted above with respect to claims 14-47. It follows that the arguments and reasoning recited above with respect to claims 14-47 are also applicable, but for the sake of brevity all of the above stated arguments are not repeated. The following provides at least one example for each allegedly dropped item explaining how the appellant’s prosecution argument during prosecution of the ‘641 patent pertains to limitations in claim 48.

1) Regarding the allegedly dropped abduction and lithotomy limitation, appellant’s arguments during prosecution of the ‘641 patent regarding these limitations are applicable to the plurality of axes recited in claim 48. The arguments do not relate to dropped subject matter and there is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

2) Regarding the allegedly dropped support device longitudinal axis, appellant’s arguments during prosecution of the ‘641 patent regarding this limitation are applicable to at least the claim 48 limitation of coupling the tube to the mounting device. The argument that Klevstad does not teach a support device that is fixed from rotation about its own longitudinal axis is applicable to the limitations in claim 48 which fix the tube to the

mounting device and permit movement about a plurality of axes. There is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

3) Regarding the allegedly dropped “transverse to said longitudinal axis”, appellant’s arguments during prosecution of the ‘641 patent with respect to this limitation refer to the abduction or lithotomy axes of the preferred embodiment which remain in claim 48 as the plurality of axes. Claim 48 is not materially narrowed in this aspect.

4) Regarding the allegedly dropped limitation of the mounting device having a first axis, appellant’s arguments during prosecution of the ‘641 patent regarding this limitation are applicable to at least the claim 48 limitation of the plurality of axes recited in claim 48. The arguments to do not relate to dropped subject matter and there is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

5) Regarding the allegedly dropped limitation “simultaneously”, appellant’s arguments during prosecution of the ‘641 patent with respect to this limitation refer to the ability to both clamp (or fix) and release which is in claim 48, “the clamping device being movable between a normal condition having the tube fixed relative to the mounting device and a release condition”. The arguments to do not relate to dropped subject matter and there is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

6) Regarding the allegedly dropped limitation concerning the support device being fixed in the clamping device against rotation about said longitudinal axis, appellant’s arguments during prosecution of the ‘641 patent with respect to this limitation refer to the claim 48 limitation of “the clamping device being movable between a normal condition having the tube fixed relative to the mounting device and a release condition”. The argument that Klevstad does not teach a support device that is fixed from rotation about its own longitudinal axis is applicable to the limitations in claim 48 which fix the tube to the mounting device and permit movement about a plurality of axes. There is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

7) Regarding the allegedly dropped limitation that the actuator device actuates the clamping device for simultaneously clamping the support device and mounting device, appellant’s arguments during prosecution of the ‘641 patent with respect to this limitation refer to the ability to both clamp and release which is in claim 48, “the clamping device being movable between a normal condition having the tube fixed relative to the mounting device and a release condition”. The arguments to do not relate to dropped subject matter and there

is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

Claim 55

Dependent claim 55 avoids the 35 U.S.C. 251 recapture rejection for substantially the same reasons as recited above with respect to claim 48. Claim 55 further requires that the tube defines a longitudinal axis. Thus, it is apparent that the allegedly dropped limitation of “having a longitudinal axis” is not dropped from claim 55 and appellant’s limited patentability arguments during prosecution of the ‘641 patent do not amount to recapture of the allegedly dropped limitations. Furthermore claim 55 recites that the operator device rotates about the longitudinal axis to move the clamping device between the normal condition and the release condition. This recitation makes it even more apparent that the allegedly dropped limitation of “simultaneously” is not dropped from claim 55 and appellant’s limited patentability arguments during prosecution of the ‘641 patent do not amount to recapture of the allegedly dropped limitations.

Claim 62

Dependent claim 62 avoids the 35 U.S.C. 251 recapture rejection for substantially the same reasons as recited above with respect to claim 48. Dependent claim 62 further requires that the first axis of the plurality of axes and the second axis of the plurality of axes are generally orthogonal. Recitation of these orthogonal axes in combination with the tube (which has an axis, as would have been apparent to one of ordinary skill in the art) provides further evidence that the allegedly dropped limitations of the “abduction dimension and lithotomy dimension”, “having a longitudinal axis”, “transverse to said longitudinal axis” and “the mounting device having a first axis” are not dropped from claim 62 and appellant’s limited patentability arguments during prosecution of the ‘641 patent do not amount to recapture of the allegedly dropped limitations.

Claims 49-54, 56-61 and 63-71

Claims 49-54, 56-61 and 63-71 depend from claim 48. Accordingly, claims 49-54, 56-61 and 63-71 avoid the 35 U.S.C. 251 recapture rejection for substantially the same reasons as recited above with respect to claim 48.

Claims 72-80 Are Not Impermissibly Broadened..

Claims 72-80 avoid the 35 U.S.C. 251 improper recapture rejection for substantially the same reasons noted above with respect to claims 14-71. The following discussion provides at least one example to explain how claims 72-80 claim the allegedly dropped subject matter. It follows that the arguments and reasoning recited above with respect to claims 14-71 are also applicable, but for the sake of brevity all of the above stated arguments are not repeated.

The side by side comparison of claims 1 and 72 demonstrates that

1) the allegedly dropped abduction and lithotomy limitation have not been improperly removed from claim 72. The abduction and lithotomy limitation are clearly described at column 3, lines 60-61 of the '641 patent and are shown, for example, in the Fig. 3 preferred embodiment as axes 36 and 72, respectively. Claim 72 recites a plurality of axes. As is apparent from the side by side comparison of new claim 72 and patented claim 1, the plurality of axes is the abduction and lithotomy axes in the preferred embodiment. Although the wording is changed, the subject matter is common to both claims. Thus, with respect to this aspect, claim 72 was not materially broadened to violate the recapture rule.

2) the allegedly dropped support device longitudinal axis 80 has not been improperly removed from claim 72. Claim 72 includes a tube, a mounting device, a clamp coupling the tube to the mounting device. The tube in the preferred embodiment has an axis 80. Thus, claim 72 in the preferred embodiment recites this aspect and is not an impermissible broadening.

3) the allegedly dropped "transverse to said longitudinal axis 80" limitation relates to the abduction or lithotomy axes in the preferred embodiment which are not improperly removed from claim 72. As explained above with respect to the allegedly dropped abduction and lithotomy limitation, in the claim 72 preferred embodiment the abduction and lithotomy limitation are clearly represented as a plurality of axes. Clearly, claim 72 is not impermissibly broadened in this aspect.

4) the allegedly dropped limitation of the mounting device having a first axis also relates to the abduction and lithotomy limitation and is not improperly removed from claim 72. Claim 72 clearly recites "a hollow tube having a bore, the tube being lockable relative to the mounting device and releasable to rotate relative to the mounting device about a plurality of axes" which again refers to the abduction and lithotomy limitation in the preferred

embodiment. Thus, the allegedly dropped limitation is not removed, but is stated in different terms which is not an impermissible broadening of the allegedly dropped limitation.

5) the allegedly dropped limitation “simultaneously” in claim 1, line 9 has not been improperly removed from claim 72. The term “simultaneously” as used in claim 1 refers to the ability to both clamp (or fix) and release. Claim 72 recites, for example, the tube being lockable relative to the mounting device and releasable. Accordingly, there has been no impermissible broadening of claim 72 in this aspect.

6) the allegedly dropped limitation concerning the support device being fixed in the clamping device against rotation about said longitudinal axis has not been improperly removed from claim 72. Claim 72 continues to recite that the support device (tube in claim 72) is fixed against rotation about said longitudinal axis in claim 72, namely “a hollow tube having a bore, the tube being lockable relative to the mounting device and releasable to rotate relative to the mounting device about a plurality of axes, a clamp spaced apart from the mounting device and coupled to the tube such that the tube passes through the clamp” includes clamping against rotation about its longitudinal axis as in the preferred embodiment. There is no impermissible broadening. Release to permit motion about two axes is another matter and is not suggestive of improper broadening or recapture. There has been no impermissible broadening of claim 72 in this aspect.

7) the allegedly dropped limitation that the actuator device actuates the clamping device for simultaneously clamping the support device and mounting device is not improperly removed from claim 72. The claim 72 recitation of “a hollow tube having a bore, the tube being lockable relative to the mounting device and releasable to rotate relative to the mounting device about a plurality of axes, a clamp spaced apart from the mounting device and coupled to the tube such that the tube passes through the clamp” is not an impermissible broadening. The claim 72 actuator device actuates the clamping device for simultaneously clamping the support device and mounting device, or as stated in claim 72, the tube is lockable relative to the mounting device. There is no material difference between what is allegedly removed and the corresponding language of claim 72. The final rejection does not point to any material difference and there has been no impermissible broadening of claim 72 in this aspect.

Claims 72-80.

Appellant's Prosecution Arguments Are Not Directed To Omitted Subject Matter.

Appellant's prosecution arguments during prosecution of the '641 patent are not directed to subject matter omitted from reissue claims 72-80. Claims 72-80 avoid the 35 U.S.C. 251 improper recapture rejection for substantially the same reasons noted above with respect to claims 14-71. It follows that the arguments and reasoning recited above with respect to claims 14-71 are also applicable, but for the sake of brevity all of the above stated arguments are not repeated. The following provides at least one example for each allegedly dropped item explaining how the appellant's prosecution argument during prosecution of the '641 patent pertains to limitations in claim 72.

1) Regarding the allegedly dropped abduction and lithotomy limitation, appellant's arguments during prosecution of the '641 patent regarding this limitation are applicable to the plurality of axes recited in claim 72 as explained, supra. The arguments do not relate to dropped subject matter and there is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

2) Regarding the allegedly dropped support device longitudinal axis, appellant's arguments during prosecution of the '641 patent regarding this limitation are applicable to at least the claim 72 limitation of a tube as explained, supra. The argument that Klevstad does not teach a support device that is fixed from rotation about its own longitudinal axis is applicable to the limitations in claim 72 which recite the tube being lockable relative to the mounting device. There is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

3) Regarding the allegedly dropped "transverse to said longitudinal axis", appellant's arguments during prosecution of the '641 patent with respect to this limitation refer to the abduction or lithotomy axes which remain in claim 72 as the plurality of axes as explained, supra. Claim 72 is not materially narrowed in this aspect.

4) Regarding the allegedly dropped limitation of the mounting device having a first axis, appellant's arguments during prosecution of the '641 patent regarding this limitation are applicable to at least the claim 72 limitation of the plurality of axes as explained, supra. The arguments do not relate to dropped subject matter and there is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

5) Regarding the allegedly dropped limitation “simultaneously”, appellant’s arguments during prosecution of the ‘641 patent with respect to this limitation refer to the ability to both clamp (or fix) and release which is in claim 72 as “the tube being lockable relative to the mounting device and releasable” as explained, supra. The arguments do not relate to dropped subject matter and there is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

6) Regarding the allegedly dropped limitation concerning the support device being fixed in the clamping device against rotation about said longitudinal axis, appellant’s arguments during prosecution of the ‘641 patent with respect to this limitation relate to the claim 72 limitation of “a hollow tube having a bore, the tube being lockable relative to the mounting device and releasable to rotate relative to the mounting device about a plurality of axes, a clamp spaced apart from the mounting device and coupled to the tube such that the tube passes through the clamp” as explained, supra. The argument that Klevstad does not teach a support device that is fixed from rotation about its own longitudinal axis is applicable to the limitations in claim 72 which fix the tube to the mounting device and permit movement about a plurality of axes. There is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

7) Regarding the allegedly dropped limitation that the actuator device actuates the clamping device for simultaneously clamping the support device and mounting device, appellant’s arguments during prosecution of the ‘641 patent with respect to this limitation refer to the ability to both clamp and release which is in claim 72 as “a hollow tube having a bore, the tube being lockable relative to the mounting device and releasable to rotate relative to the mounting device about a plurality of axes, a clamp spaced apart from the mounting device and coupled to the tube such that the tube passes through the clamp” as explained, supra. The arguments do not relate to dropped subject matter and there is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

Claims 76 and 77

Dependent claims 76 and 77 avoid the 35 U.S.C. 251 recapture rejection for substantially the same reasons as recited above with respect to claim 72. Claims 76 and 77 each further require that the tube defines a longitudinal axis. Thus, it is apparent that the allegedly dropped limitation of “having a longitudinal axis” is not dropped from claims 76

and 77 and appellant's limited patentability arguments during prosecution of the '641 patent do not amount to recapture of the allegedly dropped limitations.

Claim 78

Dependent claim 78 avoids the 35 U.S.C. 251 recapture rejection for substantially the same reasons as recited above with respect to claim 72. Dependent claim 78 further requires a clamping device coupling the tube to the mounting device, the clamping device being movable between a lock condition having the tube fixed relative to the mounting device and a release condition in which the tube is rotatable relative to the mounting device about the plurality of axes. This recitation provides further evidence that the allegedly dropped limitation of the "actuator device actuates the clamping device for simultaneously clamping the support device and mounting device" is not dropped from claim 78 and appellant's limited patentability arguments during prosecution of the '641 patent do not amount to recapture of the allegedly dropped limitations.

Claims 73-75 and 79-80

Claims 73-75 and 79-80 depend from claim 72. Accordingly, claims 73-75 and 79-80 avoid the 35 U.S.C. 251 recapture rejection for substantially the same reasons as recited above with respect to claim 72.

Claims 81-90 Are Not Impermissibly Broadened.

Claims 81-90 avoid the 35 U.S.C. 251 improper recapture rejection for substantially the same reasons noted above with respect to claims 14-80. The following discussion provides at least one example to explain where in claims 81-90 there is claimed the allegedly dropped subject matter. It follows that the arguments and reasoning recited above with respect to claims 14-80 are also applicable, but for the sake of brevity all of the above stated arguments are not repeated.

The side by side comparison of claims 1 and 81 demonstrates that

1) the allegedly dropped abduction and lithotomy limitation have not been improperly removed from claim 81. The abduction and lithotomy limitation are clearly described at column 3, lines 60-61 of the '641 patent and are shown, for example, in the Fig. 3 preferred embodiment as axes 36 and 72, respectively. Claim 81 recites a plurality of axes. As is apparent from the side by side comparison of new claim 81 and patented claim 1, the

plurality of axes relates to the abduction and lithotomy axes in the preferred embodiment as explained, supra. Although the wording is changed, the subject matter is common to both claims. Thus, with respect to this aspect, claim 81 was not materially broadened to violate the recapture rule.

2) the allegedly dropped support device longitudinal axis 80 has not been improperly removed from claim 81. Claim 81 includes an elongated element. The elongated element in the preferred embodiment has an axis 80. Thus, claim 81 in the preferred embodiment recites this aspect and is not an impermissible broadening.

3) the allegedly dropped “transverse to said longitudinal axis 80” limitation relates to the abduction or lithotomy axes in the preferred embodiment which are not improperly removed from claim 81. As explained above with respect to the allegedly dropped abduction and lithotomy limitation, both abduction and lithotomy limitations are clearly represented in the claim 81 preferred embodiment as a plurality of axes. Clearly, claim 81 is not impermissibly broadened in this aspect.

4) the allegedly dropped limitation of the mounting device having a first axis also refers to the abduction and lithotomy limitation in the preferred embodiment and is not improperly removed from claim 81. Claim 81 clearly recites “a mounting device, an elongated element lockable relative to the mounting device and releasable to rotate relative to the mounting device about a plurality of axes” which again relates to the abduction and lithotomy limitation in the preferred embodiment. Thus, the allegedly dropped limitation is not removed, but is stated in different terms which is not an impermissible broadening of the allegedly dropped limitation.

5) the allegedly dropped limitation “simultaneously” in claim 1, line 9 has not been improperly removed from claim 81. The term “simultaneously” as used in claim 1 refers to the ability to both clamp (or lock) and release. Claim 81 recites, for example, an elongated element lockable relative to the mounting device and releasable. Thus, claim 81 in the preferred embodiment recites the tube being clampable (lockable) and releasable. Accordingly, there has been no impermissible broadening of claim 81 in this aspect.

6) the allegedly dropped limitation concerning the support device being fixed in the clamping device against rotation about said longitudinal axis has not been improperly removed from claim 81. Claim 81 continues to recite that the support device (elongated element in claim 81) is fixed against rotation about said longitudinal axis in claim 81, namely

“an elongated element lockable relative to the mounting device” includes clamping against rotation about its longitudinal axis in the preferred embodiment. There is no impermissible broadening. Release to permit motion about two axes is another matter and is not suggestive of improper broadening or recapture. There has been no impermissible broadening of claim 81 in this aspect.

7) the allegedly dropped limitation that the actuator device actuates the clamping device for simultaneously clamping the support device and mounting device is not improperly removed from claim 81. The claim 81 recitation of “a mounting device, an elongated element lockable relative to the mounting device and releasable to rotate relative to the mounting device about a plurality of axes” is not an impermissible broadening. The claim 81 actuator device actuates the clamping device for simultaneously clamping the support device and mounting device, or as stated in claim 81, the elongated element is lockable relative to the mounting device. There is no material difference between what is allegedly removed and the corresponding language of claim 81. The final rejection does not point to any material difference and there has been no impermissible broadening of claim 81 in this aspect.

Claims 81-90.

Appellant’s Prosecution Arguments Are Not Directed To Omitted Subject Matter.

Appellant’s prosecution arguments during prosecution of the ‘641 patent are not directed to subject matter omitted from reissue claims 81-90. Claims 81-90 avoid the 35 U.S.C. 251 improper recapture rejection for substantially the same reasons noted above with respect to claims 14-80. It follows that the arguments and reasoning recited above with respect to claims 14-80 are also applicable, but for the sake of brevity all of the above stated arguments are not repeated. The following provides at least one example for each allegedly dropped item explaining how the appellant’s prosecution argument during prosecution of the ‘641 patent pertains to limitations in claim 81.

1) Regarding the allegedly dropped abduction and lithotomy limitation, appellant’s arguments during prosecution of the ‘641 patent regarding this limitation are applicable to the plurality of axes recited in claim 81 as explained, supra. The arguments do not relate to dropped subject matter and there is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

2) Regarding the allegedly dropped support device longitudinal axis, appellant's arguments during prosecution of the '641 patent regarding this dimension are applicable to at least the claim 81 limitation of an elongated element. The argument that Klevstad does not teach a support device that is fixed from rotation about its own longitudinal axis is applicable to the limitations in claim 81 which recite an elongated element lockable relative to the mounting device. There is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

3) Regarding the allegedly dropped "transverse to said longitudinal axis", appellant's arguments during prosecution of the '641 patent with respect to this limitation refer to the abduction or lithotomy axes which relate to claim 81 as a plurality of axes as explained, supra. Claim 81 is not materially narrowed in this aspect.

4) Regarding the allegedly dropped limitation of the mounting device having a first axis, appellant's arguments during prosecution of the '641 patent regarding this dimension are applicable to at least the claim 81 limitation of the plurality of axes recited in claim 81 as explained, supra. The arguments do not relate to dropped subject matter and there is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

5) Regarding the allegedly dropped limitation "simultaneously", appellant's arguments during prosecution of the '641 patent with respect to this limitation refer to the ability to both clamp (or lock) and release which is in claim 81, "an elongated element lockable relative to the mounting device and releasable to rotate relative to the mounting device about a plurality of axes". The arguments do not relate to dropped subject matter and there is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

6) Regarding the allegedly dropped limitation concerning the support device being fixed in the clamping device against rotation about said longitudinal axis, appellant's arguments during prosecution of the '641 patent with respect to this limitation relate to the claim 81 limitation of "a mounting device, an elongated element lockable relative to the mounting device and releasable to rotate relative to the mounting device about a plurality of axes". The argument that Klevstad does not teach a support device that is fixed from rotation about its own longitudinal axis is applicable to the limitations in claim 81 which lock the elongated element to the mounting device. There is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

7) Regarding the allegedly dropped limitation that the actuator device actuates the clamping device for simultaneously clamping the support device and mounting device, appellant's arguments during prosecution of the '641 patent with respect to this limitation refer to the ability to both clamp and release which is in claim 81, "an elongated element lockable relative to the mounting device and releasable". The arguments do not relate to dropped subject matter and there is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

Claim 84

Dependent claim 84 avoids the 35 U.S.C. 251 recapture rejection for substantially the same reasons as recited above with respect to claim 81. Claim 84 further requires that the elongated element defines a longitudinal axis as explained, supra. Thus, it is apparent that the allegedly dropped limitation of "having a longitudinal axis" is not dropped from claim 84 and appellant's limited patentability arguments during prosecution of the '641 patent do not amount to recapture of the allegedly dropped limitations.

Claim 85

Dependent claim 85 avoids the 35 U.S.C. 251 recapture rejection for substantially the same reasons as recited above with respect to claim 81. Dependent claim 85 further requires a locking device coupling the elongated element to the mounting device, the locking device being movable between a locked condition having the elongated element fixed relative to the mounting device and a release condition in which the elongated element is rotatable relative to the mounting device about the plurality of axes. This recitation provides further evidence that the allegedly dropped limitations of "simultaneously" (in claim 85, the ability to move between a locked condition and release condition) and "the support device (elongated element in claim 85) being fixed in the clamping device against rotation about said longitudinal axis" are not dropped from claim 85 and appellant's limited patentability arguments during prosecution of the '641 patent do not amount to recapture of the allegedly dropped limitations.

Claim 89

Dependent claim 89 avoids the 35 U.S.C. 251 recapture rejection for substantially the same reasons as recited above with respect to claim 81. Claim 89 further requires wherein the plurality of axes includes a first axis about which the elongated element rotates in an abduction dimension and a second axis about which the elongated element rotates in a lithotomy dimension. Thus, it is apparent that the allegedly dropped limitation of “reference to the abduction dimension and the lithotomy dimension” is not dropped from claim 89 and appellant’s limited patentability arguments during prosecution of the ‘641 patent do not amount to recapture of the allegedly dropped limitations.

Claims 82-83, 86-88 and 90

Claims 82-83, 86-88 and 90 depend from claim 81. Accordingly, claims 82-83, 86-88 and 90 avoid the 35 U.S.C. 251 recapture rejection for substantially the same reasons as recited above with respect to claim 81.

Claims 91-100 Are Not Impermissibly Broadened.

Claims 91-100 avoid the 35 U.S.C. 251 improper recapture rejection for substantially the same reasons noted above with respect to claims 14-90. The following discussion provides at least one example to explain how claims 91-100 claim the allegedly dropped subject matter. It follows that the arguments and reasoning recited above with respect to claims 14-90 are also applicable, but for the sake of brevity all of the above stated arguments are not repeated.

The side by side comparison of claims 1 and 91 demonstrates that

1) the allegedly dropped abduction and lithotomy limitation have not been improperly removed from claim 91. The abduction and lithotomy limitation is clearly described at column 3, lines 60-61 of the ‘641 patent and are shown, for example, in the Fig. 3 preferred embodiment as axes 36 and 72, respectively. Claim 91 recites a first plurality of axes. As is apparent from the side by side comparison of new claim 91 and patented claim 1, the first plurality of axes relates to the abduction and lithotomy axes in the preferred embodiment. Although the wording is changed, the subject matter is common to both claims. Thus, with respect to this aspect, claim 91 was not materially broadened and does not violate the recapture rule.

2) the allegedly dropped support device longitudinal axis 80 has not been improperly removed from claim 91. Claim 91 recites a second plurality of axes relative to the support device. The second plurality of axes is described in the specification with respect to the preferred embodiment as axes 204, 80a (80 and 80a both represent the tube axis about which the handle rotates). See col. 3, lines 62-64 and col. 5, lines 35-38 of the '641 patent. Thus, claim 91 in the preferred embodiment is at least as limiting and is not impermissibly broadened in this aspect.

3) the allegedly dropped "transverse to said longitudinal axis 80" limitation relates to the abduction or lithotomy axes which are not improperly removed from claim 91 in the preferred embodiment as explained, supra. As explained above with respect to the allegedly dropped abduction and lithotomy dimensions, both abduction and lithotomy dimensions are clearly represented in the claim 91 preferred embodiment as a first plurality of axes. Clearly, claim 91 is not impermissibly broadened in this aspect.

4) the allegedly dropped limitation of the mounting device having a first axis also relates to the abduction and lithotomy limitation in the preferred embodiment and is not improperly removed from claim 91. Claim 91 clearly recites "a support device lockable relative to the mounting device and releasable to rotate relative to the mounting device about a first plurality of axes" which again relates to the abduction and lithotomy limitation in the preferred embodiment. Thus, the allegedly dropped limitation is not removed, but is stated in different terms which is not an impermissible broadening of the allegedly dropped limitation.

5) the allegedly dropped limitation "simultaneously" in claim 1, line 9 has not been improperly removed from claim 91. The term "simultaneously" as used in claim 1 refers to the ability to both clamp (or lock) and release. Claim 91 recites, for example, a support device lockable relative to the mounting device and releasable. Thus, claim 91 in the preferred embodiment recites the tube being clampable (lockable) and releasable. Accordingly, there has been no impermissible broadening of claim 91 in this aspect.

6) the allegedly dropped limitation concerning the support device being fixed in the clamping device against rotation about said longitudinal axis has not been improperly removed from claim 91. Claim 91 continues to recite that the support device is fixed against rotation about said longitudinal axis in claim 91, namely "a support device lockable relative to the mounting device" which in the preferred embodiment includes clamping against rotation about its longitudinal axis. There is no impermissible broadening. Release to permit

motion about two axes is another matter and is not suggestive of improper broadening or recapture. There has been no impermissible broadening of claim 91 in this aspect.

7) the allegedly dropped limitation that the actuator device actuates the clamping device for simultaneously clamping the support device and mounting device is not improperly removed from claim 91. Appellant submits that the claim 91 recitation of “a first handle movable to lock the support device from rotation about the first plurality of axes relative to the mounting device and movable to unlock the support device for rotation about the first plurality of axes relative to the mounting device” is not an impermissible broadening. The claim 91 actuator device actuates the clamping device for simultaneously clamping the support device and mounting device, or as stated in claim 91, a first handle movable to lock the support device from rotation about the first plurality of axes relative to the mounting device and movable to unlock the support device. There is no material difference between what is allegedly removed and the corresponding language of claim 91. The final rejection does not point to any material difference and appellant submits that there has been no impermissible broadening of claim 91 in this aspect.

Claims 91-100.

Appellant’s Prosecution Arguments Are Not Directed To Omitted Subject Matter.

Appellant’s prosecution arguments during prosecution of the ‘641 patent are not directed to subject matter omitted from reissue claims 91-100. Claims 91-100 avoid the 35 U.S.C. 251 improper recapture rejection for substantially the same reasons noted above with respect to claims 14-90. It follows that the arguments and reasoning recited above with respect to claims 14-90 are also applicable, but for the sake of brevity all of the above stated arguments are not repeated. The following provides at least one example for each allegedly dropped item explaining how the appellant’s prosecution argument during prosecution of the ‘641 patent pertains to limitations in claim 91.

1) Regarding the allegedly dropped abduction and lithotomy limitation, appellant’s arguments during prosecution of the ‘641 patent regarding this limitation are applicable to the first plurality of axes recited in claim 91 as explained, supra. The arguments do not relate to dropped subject matter and there is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

2) Regarding the allegedly dropped support device longitudinal axis, appellant’s arguments during prosecution of the ‘641 patent regarding this dimension are applicable to at

least the claim 91 limitation of a support device and a first plurality of axes as explained, supra. The argument that Klevstad does not teach a support device that is fixed from rotation about its own longitudinal axis is applicable to the limitations in claim 91 which recite a support device lockable relative to the mounting device and releasable to rotate relative to the mounting device about a first plurality of axes. There is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

3) Regarding the allegedly dropped “transverse to said longitudinal axis”, appellant’s arguments during prosecution of the ‘641 patent with respect to this limitation relate to the abduction or lithotomy axes which remain in claim 91 as a first plurality of axes as explained, supra. Claim 91 is not materially narrowed in this aspect.

4) Regarding the allegedly dropped limitation of the mounting device having a first axis, appellant’s arguments during prosecution of the ‘641 patent regarding this dimension are applicable to at least the claim 91 limitation of the first plurality of axes recited in claim 91 as explained, supra. The arguments do not relate to dropped subject matter and there is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

5) Regarding the allegedly dropped limitation “simultaneously”, appellant’s arguments during prosecution of the ‘641 patent with respect to this limitation refer to the ability to both clamp (or lock) and release which is in claim 91, “a support device lockable relative to the mounting device and releasable”. The arguments do not relate to dropped subject matter and there is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

6) Regarding the allegedly dropped limitation concerning the support device being fixed in the clamping device against rotation about said longitudinal axis, appellant’s arguments during prosecution of the ‘641 patent with respect to this limitation refer to the claim 91 limitation of “a support device lockable relative to the mounting device”. The argument that Klevstad does not teach a support device that is fixed from rotation about its own longitudinal axis is applicable to the limitations in claim 91 which lock the elongated element to the mounting device. There is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

7) Regarding the allegedly dropped limitation that the actuator device actuates the clamping device for simultaneously clamping the support device and mounting device, appellant’s arguments during prosecution of the ‘641 patent with respect to this limitation

refer to the ability to both clamp and release which is in claim 91, “a support device lockable relative to the mounting device and releasable to rotate relative to the mounting device about a first plurality of axes”. The arguments to do not relate to dropped subject matter and there is no proper basis to assert that the arguments in this regard relate to surrendered subject matter.

Claim 94

Dependent claim 94 avoids the 35 U.S.C. 251 recapture rejection for substantially the same reasons as recited above with respect to claim 91. Claim 94 further requires the support device defines a longitudinal axis. Thus, it is apparent that the allegedly dropped limitation of “having a longitudinal axis” is not dropped from claim 94 and appellant’s limited patentability arguments during prosecution of the ‘641 patent do not amount to recapture of the allegedly dropped limitations.

Claim 95

Dependent claim 95 avoids the 35 U.S.C. 251 recapture rejection for substantially the same reasons as recited above with respect to claim 91. Dependent claim 95 further requires a locking device coupling the support device to the mounting device, the locking device being movable between a lock condition having the support device fixed relative to the mounting device and a release condition in which the support device is rotatable relative to the mounting device about the first plurality of axes. This recitation provides further evidence that the allegedly dropped limitations of “simultaneously” (in claim 95, the ability to move between a lock condition and release condition) and “the support device being fixed in the clamping device against rotation about said longitudinal axis” are not dropped from claim 95 and appellant’s limited patentability arguments during prosecution of the ‘641 patent do not amount to recapture of the allegedly dropped limitations.

Claim 99

Dependent claim 99 avoids the 35 U.S.C. 251 recapture rejection for substantially the same reasons as recited above with respect to claim 91. Claim 99 further requires wherein the first plurality of axes includes a first axis about which the support device rotates in an abduction dimension and a second axis about which the support device rotates in a lithotomy

dimension. Thus, it is apparent that the allegedly dropped limitation of “the specific reference to the abduction dimension and the lithotomy dimension” is not dropped from claim 99 and appellant’s limited patentability arguments during prosecution of the ‘641 patent do not amount to recapture of the allegedly dropped limitations.

Claims 92-93, 96-98 and 100

Claims 92-93, 96-98 and 100 depend from claim 91. Accordingly, claims 92-93, 96-98 and 100 avoid the 35 U.S.C. 251 recapture rejection for substantially the same reasons as recited above with respect to claim 91.

Conclusion of Argument

From the above, it is readily apparent that the final rejection provides no basis for any of the possible recapture prohibitions of the recapture law. For the foregoing reasons, the appellant, respectfully, requests that the rejection of claims 14-100 be reversed and the application with claims 1-100 be allowed.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response and shortages in other fees, be charged, or any overpayment in fees be credited, to the Account of Barnes & Thornburg, Deposit Account No. 10-0435 (7175/65430).

Respectfully submitted,

BARNES & THORNBURG



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